

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on January 29, 2003, and the references cited therewith.

Claims 1-4, 8, 12-15, 17, 19-20 and 22-23 are amended, claim 11 is canceled without prejudice, and no claims are added; as a result, claims 1-10 and 12-30 are now pending in this application.

Examiner Interview

Applicant thanks the Examiner for the courtesies extended during the telephone interview held on July 29, 2003, between the Examiner and Applicant's attorney during which the claims and the Shisler reference were discussed. Specifically amendments to the claims in order to overcome the rejection of claims 1, 8, 15 and 17 under 35 USC §112 were discussed. Further amendments provide antecedent basis for claim elements. The amendments to the claims are believed to be consistent with the discussion during the interview.

In addition, the Examiner and Applicant's representative agreed during the interview that claims 10, 23 and 30 were allowable over the combination of Shisler and Levine.

Finally, differences between the Shisler reference and Applicant's claims as amended above were discussed. Based on discussion during the interview and the arguments provided below, the claims are believed to be allowable over Shisler. The Examiner indicated that a further search may be performed.

§112 Rejection of the Claims

Claims 1 and 12 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 1 and 12 to clarify the "overriding" aspects of the claimed invention. Additionally, the amendments to the claims clarify that the color designation is overridden prior to printing.

Claims 8, 15, and 17 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Applicant regards as the invention. Applicant has amended claims 8, 15 and 17 to clarify that the color designation is changed prior to printing.

Applicant submits that the amendments clarify matters that were inherent in the claims when interpreted in light of the specification and are thus non-narrowing amendments.

§102 Rejection of the Claims

Claims 1, 3-5, 7-8, 10-12, 14-15, 17-19, 20-24, and 26-30 were rejected under 35 USC § 102(a) as being anticipated by Shisler et al. (U.S. Publ. No. 2001/0018708 A1). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that a *prima facie* case of anticipation does not exist because the claims recite features that are not taught or suggested by Shisler.

For example, independent claim 1 as amended recites “changing the color designation to a printing color designation ...” Independent claims 4, 8, 12, 15, 17, 19, 24 and 27 each recite similar language related to changing a color for the purposes of printing. Shisler is directed to providing a system wherein a client system can specify processing to be performed on one or more computer connected on a network (see Abstract). One aspect of this processing include producing database reports. These reports may have sections including various types of header sections, footer sections, and columnar sections (see page 4, paragraph 77). As noted in the Office Action, Shisler provides a mechanism for various properties including font and color to be overridden for the current section (see page 9, paragraph 123, emphasis added). As noted in Shisler, the new values for the properties override those that have been previously set for the section. This is unlike Applicants claimed invention in which the printing color is overridden while the display color remains unchanged. There is no mechanism disclosed in Shisler for

overriding a color for printing purposes only. Rather, once a section property is overridden, it is overridden for display purposes and the print color will presumably be the same as the display color. Because Shisler does not teach changing the color designation to a printing color designation wherein the color designation remains unchanged for display, Applicant respectfully requests the withdrawal of the rejection of claims 1, 4, 8, 12, 15, 17, 19, 24 and 27.

Claims 3, 5, 7, 10, 14, 18, 20-23, 26 and 28-30 each depend from one of independent claims 1, 4, 8, 12, 15, 17, 19, 24 and 27. Since each of these dependent claims inherit recitations related to overriding and/or changing a color for printing purposes from their respective base claims, they are allowable for the reasons discussed above. Applicant respectfully requests the withdrawal of the rejection of claims 3, 5, 7, 10, 14, 18, 20-23, 26 and 28-30.

Additionally, with respect to claims 10, 23 and 30, the Examiner indicated during the interview held July 29, 2003 that the overriding of a color based on user identification was not taught or disclosed by either Shisler or Levine. Withdrawal of the rejection of claims 10, 23 and 30 is therefore respectfully requested.

§103 Rejection of the Claims

Claims 2, 6, 9-10, 13, 16, 18 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Shisler et al. each of claims 2, 6, 9-10, 13, 16, 18 and 20 depend from one of independent claims 1, 4, 8, 12, 15, 17 and 19. Since each of these dependent claims inherit recitations related to overriding and/or changing a color for printing purposes from their respective base claims, they are allowable for the reasons discussed above with respect to the base claims. Applicant respectfully requests the withdrawal of the rejection of claims 2, 6, 9-10, 13, 16, 18 and 20.

Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over the art cited above as applied to claim 8, and further in view of Levine et al. (6,167,439). As noted above, the Examiner indicated during the interview held July 29, 2003 that the overriding of a color based on user identification was not taught or disclosed by either Shisler or Levine. Withdrawal of the rejection of claim 10 is therefore respectfully requested.

CONCLUSION

Applicant respectfully submits that the pending claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

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Date July 29, 2003

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on this 29th day of July, 2003.

Candis B. Buending

Name

Signature